

REMARKS

Claims 1-15, 17-23 and 26-29 are in the case. Claims 1, 11, 22 and 26 have been amended to correct typographical errors made in Applicant's previous reply. Applicant respectfully requests reconsideration in view of the following remarks.

Rejection Under 35 U.S.C. §112

Claims 1-15, 17-23 and 26-29 have been rejected as being indefinite. The Examiner asserts that the phrase "said aperture, said lower cushion surface of said first cushion, exposed at the aperture" is awkward, confusing and vague. Applicant respectfully submits that the Examiner is taking these words out of context. The entire phrase, of which these words are merely a part, reads as follows:

the outsole further comprising a recess wall surface extending generally upwards from the lower surface toward the upper surface and defining a recessed region in communication, at its upper reaches, with said aperture, said lower cushion surface of said first cushion, exposed at the aperture within said recessed region, being spaced by said recessed wall surface of said outsole above the floor or ground surface at all times, including when said first cushion deforms and flows under the wearer's weight and force of heel strike.

While the words cited by the Examiner may sound awkward or confusing when taken out of context, Applicant respectfully submits that, when considered in context they are perfectly clear and definite. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Rejections Under 35 U.S.C. §102

Claims 1-6, 8, 11, 13-15, 17, 22, 23 and 26 have been rejected as being anticipated by Schenkel. Claims 1, 4-6, 11, 12, 15, 17 and 26 have been rejected as being anticipated by Fuerst. These rejections will be addressed in turn.

With regard to Schenkel, the Examiner bases the rejection solely on the assertion that cushions (E) "flow." This assertion, in turn, is based on the Examiner's selection of a definition

of the word flow: "to deform under stress without cracking or rupturing." Applicant notes that this definition is listed seventh out of eight possible definitions of the word "flow" in Webster's Dictionary, and is said to be "used especially of minerals and rocks." The Examiner's selection of this definition from the many alternative, and more frequently used, meanings is improper. This use of the term "flow" is clearly inconsistent with the manner in which this term is used in Applicant's specification, to refer to soft gelatinous materials. A more appropriate definition is definition 1(b): "to move with a continual change of place among the constituent particles <the molasses *flowed* smoothly>." When the term "flow" is defined appropriately in light of Applicant's specification and its common meaning, it is clear that the Schenkel insert cannot fairly be said to flow.

Accordingly, Applicant submits that this rejection is improper and respectfully requests that it be withdrawn.

With regard to Fuerst, the Examiner states that "the functional recitation of 'said lower cushion surface...being spaced...at all times'" is considered an intended use recitation and encompassed by the use of walking which is discussed by Fuerst." Applicant disagrees. The language pointed out by the Examiner is not merely a statement of intended use. The language the Examiner refers to reads in full as follows:

said lower cushion surface of said first cushion, exposed at the aperture within said recessed region, being spaced by said recessed wall surface of said outsole above the floor or ground surface at all times, including when said first cushion deforms and flows under the wearer's weight and force of heel strike (emphasis added).

Without question, this clause includes structural limitations (e.g., "spaced by said recessed wall surface of said outsole") that cannot simply be ignored by the Examiner. If these limitations are given patentable weight – as they must be – the Examiner's rejection is baseless and Applicant's claims are clearly not anticipated. For example, Fuerst lacks the claimed recessed wall surface, which spaces the lower cushion surface above the floor or ground surface at all times. Instead, Fuerst expressly states that the lower face 35 of his ribbed ring 32 flattens out when weight is applied to the sole, allowing the dome-shaped portion to contact the ground,

as indicated by the phantom lines in Fig. 5. The flattening of the lower face 35, and contact of the dome-shaped surface with the floor, "provides a superior cushioning effect at these two locations in particular, without resulting in excessive wear of the skin of the polyurethane insert lower surface." (See, e.g., col. 3, lines 24-34.) Thus, not only does Fuerst not teach or fairly suggest Applicant's claimed structure, Fuerst expressly teaches away from it. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Rejections Under 35 U.S.C. §103

The Examiner has maintained the various obviousness rejections made in the previous office action. Each of these rejections is based on a primary reference in combination with Fuerst, and in each rejection Fuerst is cited to provide a teaching of a recess having sufficient depth to maintain an insert spaced above the ground when the wearer is walking – a teaching that is lacking in each of the primary references.

However, as discussed above, Fuerst does not supply a teaching of Applicant's claimed structure, but instead teaches expressly away from such a structure. Thus, Applicant submits that the Examiner has not established *prima facie* obviousness.

In responding to Applicant's previous remarks, the Examiner states that "it is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim to distinguish over the prior art." While this is true, this statement does not apply to the present facts. The "newly discovered function" recited by Applicant, i.e., that the lower cushion surface is maintained spaced above the floor or ground *at all times*, was not inherently possessed by the Fuerst shoe. Fuerst states repeatedly, in no uncertain terms, that his shoe is designed specifically so that the dome-shaped portion will contact the floor or ground.

The Examiner further asserts that "the structure of Fuerst is clearly capable of performing the function 'said lower cushion surface of said first cushion...being spaced by...at all times' especially when the wearer is low weight, participates in low force activities, etc." Applicant disagrees. There is simply no indication that the Fuerst shoe would perform in this manner, and

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to suggest otherwise is no more than mere conjecture. Fuerst does not suggest that his shoe only functions properly when used by heavy users or under high impact.

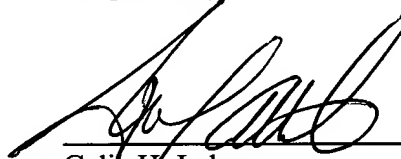
While Applicant does not agree with the Examiner's contentions regarding Pavone, these contentions are moot since Fuerst does not supply that which is lacking in the primary references, including Pavone.

In view of the above, Applicant respectfully requests that the obviousness rejections be withdrawn.

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Respectfully submitted,

Date: August 28, 2003



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